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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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30741 1633 10/27/00 71440

IN 31274/0001800

EXAMINER

CHEN, S

ART UNIT	PAPER NUMBER
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1633

DATE MAILED:

10/10/01

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Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/427,699

Applicant(s)

ZHAO ET AL.

Examiner

Shin-Lin Chen

Art Unit

1633

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED. (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 1-5 and 7-12 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) 1-5 and 7-12 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Art Unit: 1633

DETAILED ACTION

Applicants' amendment, terminal disclaimer and declaration filed 8-2-01 have been entered. Claim 10 has been amended. Claims 1-5 and 7-12 are pending and under consideration.

Terminal Disclaimer

1. The terminal disclaimer filed on 8-2-01 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of Patent No. 5,753,263 has been reviewed and is accepted. The terminal disclaimer has been recorded.

Oath/Declaration

2. The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because:

The provisional application claimed for priority should be **60/105,831** not 60/105,725 since the claimed provisional application for priority in the oath and declaration filed 12-6-00 is 60/105,831. Appropriate correction is required.

Claim Rejections - 35 USC § 102

Art Unit: 1633

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

(f) he did not himself invent the subject matter sought to be patented.

4. Claims 1-5 and 7 remain rejected under 35 U.S.C. 102(e) as being clearly anticipated by Lishko et al., US Patent No. 5,753,263. Applicant's arguments filed 8-2-01 have been fully considered but they are not persuasive.

Applicants submitted a statement of Ms. Lingna Li, a consent of the assignee, and a new oath and declaration to obviate the rejection. This is not found persuasive because of the reasons set forth in the preceding Official action mailed 2-28-01 (Paper No. 9) and that the statement of Ms. Lingna Li, the consent of the assignee, and the new oath and declaration all are not executed. No signature of the inventor or the assignee is included.

Claims 1-5 and 7 remain rejected under 102(f) or (g) as the issue of priority under 35 U.S.C. 102(g) and possibly 35 U.S.C. 102(f) of the present invention needs to be resolved. Applicant's arguments filed 8-2-01 have been fully considered but they are not persuasive.

Applicants submitted a statement of Ms. Lingna Li, a consent of the assignee, and a new oath and declaration to obviate the rejection. This is not found persuasive because of the reasons

Art Unit: 1633

set forth in the preceding Official action mailed 2-28-01 (Paper No. 9) and that the statement of Ms. Lingna Li, the consent of the assignee, and the new oath and declaration all are not executed. No signature of the inventor or the assignee is included.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 8-12 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Lishko et al., US Patent No. 5,753,263 in view of Ludin et al., 1996 (Gene, Vol. 173, p. 107-111). Applicant's arguments filed 8-2-01 have been fully considered but they are not persuasive.

Art Unit: 1633

Applicants submitted a statement of Ms. Lingna Li, a consent of the assignee, and a new oath and declaration to obviate the rejection. This is not found persuasive because of the reasons set forth in the preceding Official action mailed 2-28-01 (Paper No. 9) and that the statement of Ms. Lingna Li, the consent of the assignee, and the new oath and declaration all are not executed. No signature of the inventor or the assignee is included.

Conclusion

No claim is allowed.

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Art Unit: 1633

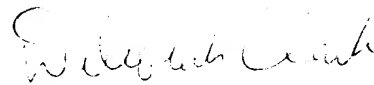
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shin-Lin Chen whose telephone number is (703) 305-1678. The examiner can normally be reached on Monday to Friday from 9 am to 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Deborah Clark can be reached on (703) 305-4051. The fax phone number for this group is (703) 308-4242.

Questions of formal matters can be directed to the patent analyst, Kimberly Davis, whose telephone number is (703) 305-3015.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist, whose telephone number is (703) 308-0196.

Shin-Lin Chen, Ph.D.


DEBORAH J. CLARK
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600